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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,108	03/09/2000	Jeffrey A. Schriebman	6425/53530	3285

30505 7590 10/07/2004

MARK J. SPOLYAR  
38 FOUNTAIN ST.  
SAN FRANCISCO, CA 94114

EXAMINER
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BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/522,108	SCHRIEBMAN, JEFFREY A.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vincent F. Boccio	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-35 and 37-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11, 28-35, 37 and 43-49 is/are allowed.
- 6) ☒ Claim(s) 12-18, 20, 25-27, 38 and 40-42 is/are rejected.
- 7) ☒ Claim(s) 21-24 and 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/12/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner. 1125
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2616.

**Response to Arguments**

1. Applicant's arguments with respect to amended claims 12-18, 20, 25-27, 38 and 40-42 have been considered but are moot in view of the new ground(s) of rejection.

**Claim Rejections - 35 USC § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-18, 20, 25-27 and 38, 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinghorn (US 6,192,187) taken with the disclosed prior art applicant's disclosure pages 1-2, Fig. 1 and further in view of Kirkland (US 5,677,739).

Regarding claims 12-18, the examiner incorporates by reference the last action against the claims.

Claim 12 will further be addressed in view of the added amended claim limitations as recited.

Claim 12 as amended further recites, the limitation,

"step b, encoding and step c, merging control data in a digital video data file",

wherein the merging step c, comprises:

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"step c1, inserting {actual merge}, the control data in the digital video data file", and

"step c2, editing (in the desired or proper, location or position thereafter merging or inserting, the process or editing), the digital video data file (source video), to accept (positioning), the control data inserted in step c1".

As amended, the combination as applied fails to particularly teach, wherein the source video is digital, wherein control data is inserted into the digital video.

Kirkland, teaches encoding descriptions and text characters into the VBI (col. 2, etc.);

- facilitated by a digital computer which receives the description data corresponding to an audiovisual program or a TV digital TV video signal (cols. 3 and col. 6);
- wherein the editor is in the form of a computer program (col. 5, operating on a computer platform, being, an editor, wherein the data is prepared to generate a computer file including text, time codes and command information);
- into line 21 or channel C1 or C2 or EDS or any line of the VBI may be used, as taught by Kirkland.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination, by merging with digital video, having control data in a data structure, even on a computer platform received and/or creating with a computer and merging with editing program, into such as the VBI {encoder/encoding}, the data, as desired, as taught by Kirkland, as is obvious to those skilled in the art, base on the combination as applied.

Claims 13-18 are considered met by the combination as applied with the incorporated by reference last detailed office action, even with the dependencies modified and other slight amendments to the claims, all limitations are considered to be met by the combination, as previously applied.

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Claims 20, 25-27, 38, 40-42 are analyzed and discussed with respect to the claims above, wherein as further recited in claim 20,

O generating a control data image frame with a line having control data corresponding to a line in the VBI, is met by after merging, the system meet the limitation of having or generating a control data image frame with VBI data, as recited.

**Allowable Subject Matter**

1. Claims 1-11 & 28-35, 37 and 43-49 are allowed, based reasons of record, even after a new search.
2. Claims 21-24 and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 21, the prior art fails to suggest in combination with the recited limitations of claim 20, in combination with limitations of claim 21, as recited, the prior art fails to teach, disclose or fairly suggest,

- step d, merging the {generated}, control data image frame (a generated frame with encoded control data);
- with a desired video frame in the video data file.

The prior art fails to suggest,

- creating or generating {a video frame data structure, with control data encoded thereto}, and to thereafter to merge, this generated frame with encoded control data, with a desired video frame (actual video frame), to create or generate, **a video frame with control data**, by merging these two frames (desired video frame & {created or generated video frame with control data}).

Claim 39 is allowed for substantially the same reasons as claim 21.

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**Conclusion**

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Contact Fax Information**

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

**Contact Information**

4. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent  
10/4/04

  
VINCENT BOCCIO  
PRIMARY EXAMINER